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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,386	07/18/2003	Andreas Wenning	234391US0	2455
22850	7590	03/18/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			NILAND, PATRICK DENNIS	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1714

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,386

Applicant(s)

WENNING ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/03</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 16-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/622639. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims overlap in scope such that it would have been obvious to one of ordinary skill in the art to perform the instantly claimed inventions from the claims of the copending application due to their close scope. The copending claims do not require succinic acid and therefore read on the instantly claimed amounts thereof. The polyesters of the copending application will be made of polyols and polyacids as that is the most common way they are made and that is what they are described as being in the copending specification.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6710136 Grenda et al.. Although the conflicting claims are not identical, they are not patentably distinct from each

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other because although the claims differ somewhat in scope, they overlap to the extent that it would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed parameters in the coating of the patentee. The instantly claimed amount of succinic acid in the claimed polyester and the lower amount of succinic acid of the patent claims overlap in terms of mathematical accuracy and within the accuracy possible in measuring such amounts with the current technology. For example, 14.99 mole % reads on the instant claims and rounds up to 15 mole % of the patented claims. No unexpected results are seen within the degree of mathematical accuracy in which the instant claims overlap.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country; more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6710136 Grenda et al..

Grenda et al. discloses the instantly claimed inventions. See the abstract; column 1, lines 65-67; column 2, lines 1-67; column 3, lines 1-40 and the remainder of the document. The instantly claimed amount of succinic acid in the claimed polyester and the lower amount of succinic acid of the patent claims overlap in terms of mathematical accuracy and within the accuracy possible in measuring such amounts with the current technology. For example, 14.99 mole % reads on the instant claims and rounds up to 15 mole % of the patented claims. No unexpected results are

seen within the degree of mathematical accuracy in which the instant claims overlap. Since the polyester forming ingredients of Grenda fall within those of the instant claims and are linear with little or no branching, the polyester of the patentee is expected to be crystalline and possess the instantly claimed melting point within the instantly claimed broad range of melting points. See table 2 for the instantly claimed gloss of claim 25.

6. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6710136 Grenda et al..

Grenda et al. discloses the instantly claimed inventions. See the abstract; column 1, lines 65-67; column 2, lines 1-67; column 3, lines 1-40 and the remainder of the document. The instantly claimed amount of succinic acid in the claimed polyester and the lower amount of succinic acid of the patent claims overlap in terms of mathematical accuracy and within the accuracy possible in measuring such amounts with the current technology. For example, 14.99 mole % reads on the instant claims and rounds up to 15 mole % of the patented claims. No unexpected results are seen within the degree of mathematical accuracy in which the instant claims overlap. Since the polyester forming ingredients of Grenda fall within those of the instant claims and are linear with little or no branching, the polyester of the patentee is expected to be crystalline and possess the instantly claimed melting point within the instantly claimed broad range of melting points. See table 2 for the instantly claimed gloss of claim 25. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients having the properties of the instant claims because they are encompassed by the patentee, as stated above, and would have been expected to give coatings having the properties described by the patentee.

7. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pub. No. 2002/0045717 A1 Grenda et al..

Grenda et al. discloses the instantly claimed inventions. See the abstract; page 1, sections [0011] through [0023]; page 2, sections [0024] through [0037]; page 3, sections [0038] through [0040] and the remainder of the document. The instantly claimed amount of succinic acid in the claimed polyester and the lower amount of succinic acid of the patent claims overlap in terms of mathematical accuracy and within the accuracy possible in measuring such amounts with the current technology. For example, 14.99 mole % reads on the instant claims and rounds up to 15 mole % of the patented claims. No unexpected results are seen within the degree of mathematical accuracy in which the instant claims overlap. Since the polyester forming ingredients of Grenda fall within those of the instant claims and are linear with little or no branching, the polyester of the patentee is expected to be crystalline and possess the instantly claimed melting point within the instantly claimed broad range of melting points. See table 2 for the instantly claimed gloss of claim 25.

8. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0045717 A1 Grenda et al..

Grenda et al. discloses the instantly claimed inventions. See the abstract; page 1, sections [0011] through [0023]; page 2, sections [0024] through [0037]; page 3, sections [0038] through [0040] and the remainder of the document. The instantly claimed amount of succinic acid in the claimed polyester and the lower amount of succinic acid of the patent claims overlap in terms of mathematical accuracy and within the accuracy possible in measuring such amounts with the current technology. For example, 14.99 mole % reads on the instant claims and rounds up to 15

mole % of the patented claims. No unexpected results are seen within the degree of mathematical accuracy in which the instant claims overlap. Since the polyester forming ingredients of Grenda fall within those of the instant claims and are linear with little or no branching, the polyester of the patentee is expected to be crystalline and possess the instantly claimed melting point within the instantly claimed broad range of melting points. See table 2 for the instantly claimed gloss of claim 25.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients having the properties of the instant claims because they are encompassed by the patentee, as stated above, and would have been expected to give coatings having the properties described by the patentee.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland
Primary Examiner
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